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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,402	01/22/2004	Hajime Mizutani	U 014997-7	4538
140	7590	01/18/2006	EXAMINER	
LADAS & PARRY 26 WEST 61ST STREET NEW YORK, NY 10023			COLILLA, DANIEL JAMES	
			ART UNIT	PAPER NUMBER
			2854	

DATE MAILED: 01/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/763,402

Applicant(s)

MIZUTANI ET AL.

Examiner

Daniel J. Colilla

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2005.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) 12-22 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 12-14, 17-23 and 25-27 is/are rejected.  
7) ☒ Claim(s) 15, 16, 24 and 28-32 is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 01 July 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/9/05.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Drawings***

1. Figure 7 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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3. Claims 12, 14 and 21 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 4 of copending Application No. 10/675,866 (hereafter '866) in view of Kitagawa et al. (US 6,176,286).

With respect to claim 12, claim 4 of '866 discloses all the recited structure of claim 12 of the present application except for the feed means and the elastic layer having a hardness value of HA40 or more. Claim 4 of '866 depends from claim 1 and therefore includes all the limitations of claim 1 of '866.

While claim 1 of '866 recites that the elastic material layer is set in a value less than HA40, it is noted that the difference between a value that is less than HA40 and that is more than HA40 is infinitesimally small and thus a value more than HA40 would have been obvious to one of ordinary skill in the art through routine experimentation.

Kitagawa et al. teaches a transferring unit including a feed means 20A,20B for superimposing a transferring film 18 atop a recording material 16 as shown in Figure 1 of Kitagawa et al. It would have been obvious to combine the teaching of Kitagawa et al. with the transferring unit disclosed by claim 4 of '866 for the advantage of aligning the transferring film and recording material in the same plane before applying the heat and pressure from the bonding means and thus creating a better bond between the transferring film and recording material.

With respect to claim 14, Kitagawa et al. teaches that a heater (not shown) is contained inside the roller 21A (Kitagawa et al., col. 6, lines 49-55).

With respect to claim 21, the thickness of the film 18 taught by Kitagawa et al. is not known to the examiner. However, the optimal thickness for the film is an obvious matter that

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could have been readily determined by one of ordinary skill in the art through routine experimentation.

This is a provisional obviousness-type double patenting rejection.

4. Claims 13 and 17 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 6 of copending Application No. 10/675,866 (hereafter '866) in view of Kitagawa et al. (US 6,176,286) and Shibano et al. (US 2002/0027313).

With respect to claim 13, '866 in view of Kitagawa et al. teaches the claimed invention as mentioned above with respect to claim 12, except that it is not known what the substrate is comprised of. However, Shibano et al. teaches a substrate for releasing material adhered to that includes a polypropylene film (Shibano et al., paragraph [0004], lines 22-28). It would have been obvious to combine the teaching of Shibano et al. with the transferring unit disclosed by '866 in view of Kitagawa et al. for the advantage of the silicone coating which aids in releasing the material adhered to the polypropylene substrate.

With respect to claim 17, Shibano et al. teaches in paragraph [0035] that the polypropylene film has a thickness of 5 $\mu$ m which is the range recited in claim 17.

This is a provisional obviousness-type double patenting rejection.

5. Claim 18 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 6 of copending Application No. 10/675,866 (hereafter '866) in view of Kitagawa et al. (US 6,176,286).

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With respect to claim 18, '866 in view of Kitagawa et al. teaches the claimed invention as mentioned above with respect to claim 12, and claim 6 of '866 further recites that the thickness of the transferable protective layer is from 2 to 20 $\mu$ m.

6. Claim 19 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 7 of copending Application No. 10/675,866 (hereafter '866) in view of Kitagawa et al. (US 6,176,286).

With respect to claim 19, '866 in view of Kitagawa et al. teaches the claimed invention as mentioned above with respect to claim 12, and claim 7 of '866 further recites that the transferable protective layer can be a compound selected from the group of materials listed in claim 7 of '866.

7. Claim 20 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 8 of copending Application No. 10/675,866 (hereafter '866) in view of Kitagawa et al. (US 6,176,286).

With respect to claim 20, '866 in view of Kitagawa et al. teaches the claimed invention as mentioned above with respect to claim 12, and claim 8 of '866 further recites an ink jet recording apparatus comprising the previously recited transferring unit of claim 4 of '866. The ink jet recording apparatus recited includes ink jet recording means (an ink jet recording portion).

8. Claims 22-23 and 25 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 8 of copending Application No. 10/675,866 (hereafter '866) in view of Kitagawa et al. (US 6,176,286).

With respect to claim 22, Claim 8 of '866 discloses all the recited steps of claim 12 of the present application except for the step of superimposing the transferring film atop the recording material and the elastic layer having a hardness value of HA40 or more. Claim 8 of '866 depends from claim 4 which in turn depends from claim 1 and therefore includes all the limitations of claims 4 and 1 of '866.

Claim 8 of '866 discloses a method of forming an ink image on the recording surface by ejecting an ink onto the recording surface.

While claim 1 of '866 recites that the elastic material layer is set in a value less than HA40, it is noted that the difference between a value that is less than HA40 and that is more than HA40 is infinitesimally small and thus a value more than HA40 would have been obvious to one of ordinary skill in the art through routine experimentation.

Kitagawa et al. teaches a transferring unit including the step of superimposing a transferring film 18 atop a recording material 16 with a feed means 20A,20B as shown in Figure 1 of Kitagawa et al. It would have been obvious to combine the teaching of Kitagawa et al. with the transferring unit disclosed by claim 4 of '866 for the advantage of aligning the transferring film and recording material in the same plane before applying the heat and pressure from the bonding means and thus creating a better bond between the transferring film and recording material.

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With respect to claim 23, claim 4 of '866 recites peeling the heat-resistant substrate off the laminated sheet which includes the transferring film.

With respect to claim 25, the thickness of the elastic layer is not known to the examiner. However, the optimal thickness for the elastic layer is an obvious matter that could have been readily determined by one of ordinary skill in the art through routine experimentation.

This is a provisional obviousness-type double patenting rejection.

9. Claims 26 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 6 of copending Application No. 10/675,866 (hereafter '866) in view of Kitagawa et al. (US 6,176,286) and Shibano et al. (US 2002/0027313).

With respect to claim 26, '866 in view of Kitagawa et al. teaches the claimed invention as mentioned above with respect to claim 22, except that it is not known what the substrate is comprised of. However, Shibano et al. teaches a substrate for releasing material adhered to that includes a polypropylene film (Shibano et al., paragraph [0004], lines 22-28). It would have been obvious to combine the teaching of Shibano et al. with the transferring unit disclosed by '866 in view of Kitagawa et al. for the advantage of the silicone coating which aids in releasing the material adhered to the polypropylene substrate.

With respect to claim 17, Shibano et al. teaches in paragraph [0035] that the polypropylene film has a thickness of 5 $\mu$ m which is the range recited in claim 17.

This is a provisional obviousness-type double patenting rejection.



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10. Claim 27 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 6 of copending Application No. 10/675,866 (hereafter '866) in view of Kitagawa et al. (US 6,176,286).

With respect to claim 27, '866 in view of Kitagawa et al. teaches the claimed invention as mentioned above with respect to claim 12, and claim 6 of '866 further recites that the thickness of the transferable protective layer is from 2 to 20 $\mu$ m.

***Allowable Subject Matter***

11. Claims 15-16, 24, and 27-32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. Claims 12-32 would be allowable if, as mentioned above, terminal disclaimer is filed to overcome the double patenting rejection set forth in this Office action.

13. The following is a statement of reasons for the indication of allowable subject matter:

Claims 12-32 have been indicated as containing allowable subject matter primarily for the specific height and pitch of the raised portions of the recording material used in combination with the specific hardness of the elastic material of the cylindrical roll main body.

***Response to Arguments***

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14. Applicant's arguments with respect to claims 1-11 have been considered but are moot in view of the new ground(s) of rejection.

With respect to applicant's regarding the hardness of the elastic material, as mentioned above, the exact hardness of the elastic layer could have readily been determined through routine experimentation by one of ordinary skill in the art.

It is also noted that no drawing submission could be found in applicant's response file 11/9/05 as stated in applicant's remarks.

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


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16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel J. Colilla whose telephone number is 571-272-2157. The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on 571-272-2168. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

January 10, 2006

  
Daniel J. Colilla  
Primary Examiner  
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